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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/836,870 | 04/17/2001 | Claude Jarkae Jensen | 10209.166 | 5882 |
| 21999 | 7590 | 10/02/2003 | EXAMINER | |
| KIRTON AND MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE P O BOX 45120 SALT LAKE CITY, UT 84145-0120 | | | YU, GINA C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1617 | |
| | | | DATE MAILED: 10/02/2003 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,870

Applicant(s)

JENSEN ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 30, 2003 has been entered. Claims 1, 2, and 4-28 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement test requires require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. See MPEP § 2164.01, reciting In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988).

To determine whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary

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experimentation is "undue", following factors are considered: the breadth of the claims; the nature of the invention; the state of the prior art; the level of one of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the content of the disclosure. See In re Wands, at 737

In this case, applicants' disclosure does not enable the claimed method of balancing pH by topically applying a composition comprising a cosmetic carrier, which may be as simple as water, and any quantity of noni fruit juice. There is nothing in the record, either applicants' disclosure or the prior arts, to indicate that noni fruit juice itself in any quantity is effective as a pH-balancing agent. No working examples or directions are provided show how to balance pH with such combination of a carrier and noni fruit juice alone, as claimed in the instant claims 1 and 26. A skilled artisan would need undue experimentations to test the efficacy of the claimed method of balancing pH of the skin, and thus the enablement rejection is proper.

Claims 1, 2, 4-24 are rejected as depending on claim 1, the base claim that is not enabled.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 27 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “a quantity” renders the claim vague and indefinite, as the metes and bounds of the scope of the claim is not clear.

While claim 27 recites a “balancing agent”, the term renders the claim vague and indefinite. The term is not defined by specification, and the metes and bounds of the scope of the claim are uncertain. While applicants refer the disclosed ingredients in the composition the ingredients “typically employed in a toner”, examiner notes that such broad definition does not define the term “balancing agent”. See spec. p. 26-27.

Similarly, the term “hydrating agent” in claim 28 renders the claim vague and indefinite, as the metes and bounds of the scope of the claim are not clear.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, and 4-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo (JP 200095663A, machine translation) in view of Moniz and Duffy et al. (US 5472699).

Kondo teaches cosmetic composition comprising plant extracts which provide skin whitening, oxygen scavenging and/or antimicrobial effect. *Morinda Citrifolia* (noni) is among the plant extracts disclosed in the reference. See translation, paragraphs [0001- -0009]. Kondo further teaches the invention may be formulated into various types of cosmetic compositions, including skin care lotion and face toilet, which is

considered as a skin toner product. See translation, paragraph [0017]. The whitening effect of Mulberry bark extract (which is deemed to be noni) is also discussed in paragraphs [0025-36] and Table 2. The reference further teaches that the cosmetic compositions may include the additives that meet instant claims 19-26. The reference teaches also using astringent. See paragraph [0020].

While the cosmetic formulation in Kondo contains 4.8 % of *Morinda Citrifolia* (noni), differences in concentration in general will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05. Since the general conditions of the instant claims are disclosed in Kondo, examiner views that one having ordinary skill in the art would have discovered the optimum or workable ranges by routine experimentation. Increasing the concentration of noni would be desirable to enhance the whitening, antioxidant, and antibacterial effect of the composition.

The example composition in Kondo contains the bark extract of noni, examiner takes the position it would have been obvious to a skilled artisan that other parts of the same plant would inherently provide the same effects.

Moniz further teaches the topical use of poultice made with noni, which is a moisture mess, is well known for its medicinal effects. See col. 1, lines 56 – 66. Examiner takes the position that the recited “release of xeronine” in claims 1 and 2 necessarily takes place in the topical application of noni fruit juice or the in the juice itself.

Duffy teaches an aqueous cosmetic composition comprising botanical astringent comprising extracts from Witch Hazel, Linden which is a source of vitamin C, E, and farnesol, and St. John's Wort which is a source of vitamin A. Employing silica, water, ethyl alcohol (denatured alcohol), glycerin (a humectant), pyridoxine HCL, fragrances, thickeners, preservatives, and colorants are also disclosed. See col. 4, line 36 – col. 6, line 34. The reference teaches that the invention helps reduce the size of pore of the skin and control sebum secretion. See col. 2, lines 18 – 52.

Given the general teaching of making cosmetic compositions from noni in Kondo and the topical use of noni in Moniz, one of ordinary skill in the art at the time the invention was made to have looked to prior arts such as Duffy for specific additive components suitable for botanical astringents and modified the composition of Kondo by incorporating such additives because of the expectation of successfully producing a skin care composition that improves skin appearance by whitening the skin, reducing the pore size and controlling oil secretion, and/or provides antiseptic effect. The method of topically applying the said composition to hydrate and balance pH of the skin would have been an obvious use of the combined toner composition comprising an astringent and humectant.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 4-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner


THEODORE J. CRIARES
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